

Appl. No. 09/397,455

Attorney Docket: 042390.P6764

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated January 13, 2005, in which:

- claims 1, 2, and 4-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Grimmer (US Patent No. 5,774,552) in combination with Van Oorschot (US Patent No. 6,215,872 B1).

Reconsideration of the above referenced patent application in view of the following remarks is respectfully requested.

Claims 1, 2, & 4-26 are now pending the above referenced patent application. No claims have been amended, cancelled, or added.

1. 35 U.S.C. § 103(a)***1.1. Grimmer and Van Oorschot: Claims 1, 2, and 4-26***

The PTO has also rejected claims 1, 2, and 4-26 under 35 U.S.C. § 103(a) based upon Grimmer in combination with Van Oorschot. The rejection of these claims is respectfully traversed.

M.P.E.P. § 706.02(j) sets forth the standard for a § 103(a) rejection:

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.

Second, there must be a reasonable expectation of success.

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Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (whitespace added).

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

Applicant begins with claim 1. Claim 1 recites:

- 1 1. (Previously Presented) A method comprising:
- 2 reading from a software module embedding one of a set of key associated with a
- 3 trusted source;
- 4 determining whether a key is traceable to one of the set of keys;
- 5 determining whether the key is identified in a list of compromised keys; and
- 6 if the key is not identified as compromised and is traceable to one of the keys in
- 7 the set, assigning the key a trusted status.

Applicants respectfully assert that the combination set forth by the PTO fails to meet the requirement for a *prima facie* case for a § 103(a) rejection for at least the following reasons.

It is respectfully asserted that neither Grimmer nor Van Oorschot, either alone or in combination, suggests or describes all the elements and limitations of claim 1.

As stated in the reply to the April 19, 2004 Office Action, Grimmer does not show, teach, use, or describe a reading from a software module embedding one of a set of key associated with a trusted source. Grimmer instead shows reading a set of keys from a database (the Certificate Authority, or LDAP of Fig. 6). It is respectfully asserted that Grimmer shows using a software module to perform encryption.

Applicant respectfully contends that in order to fulfill the first element of Claim 1 a piece of prior art, or a combination thereof, must, at a minimum:

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- a) Cause the method to read from
- b) a software module
- c) that has embedded within the software module
- d) one of a set of keys...

Applicant respectfully asserts that the public keys of Grimmer and Van Oorchot are not (c) embedded within a software module. Grimmer instead shows the public key being stored within an external database. See Column 6, lines 36-38, and Fig. 6.

Applicant respectfully asserts that Van Oorchot does not ameliorate this deficiency. Van Oorchot instead shows public keys stored within a database, which is accessed by the security manager (software module). Applicant respectfully asserts that Figure 1 of Van Oorchot clearly shows that the security managers (Fig. 1, elements 12-16) are separate and distinct from the database directory (Fig. 1, element 18). It is also noted that Van Oorchot describes the security managers as separate "personal computers" that share the common directory. (See, Col. 3, lines 60-67.) Therefore, the common directory can not be embedded within each of the security managers.

Therefore, even if the combination were proper, although Applicant believes that it is not, nonetheless, the combination would still fail to produce the invention as recited in the rejected claims. It is, therefore, respectfully requested that the rejection of this claim be withdrawn.

Claims 2 and 4-26 either depend from and include the limitations of claim 1, or include a substantially similar and patentably distinct limitation as claim 1. Therefore, these claims patentably distinguish from the cited patents on the same basis as claim 1. It is, therefore, respectfully requested that the PTO withdraw the rejections of these claims.


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CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 503-264-7002. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,


Justin B. Scout
Reg. No. 54,431

Dated:

Tue Apr 12, 2005

c/o Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025-1026
(503) 264-0967